

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing changes to the pending claims.

Status of the Claims

In the present Reply, independent claims 6-9 have been amended. Claim 19 has been canceled herein without prejudice or disclaimer of the subject matter contained therein. Claims 1-5 and 10-13 and 15-18 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 6-9 are pending in the present application.

No new matter has been added by way of these amendments. For instance, regarding claim 1, this amendment is supported by the subject matter canceled from claim 19 and in the present specification at least at page 7, lines 11-12, page 8, lines 12-22 and the various Examples. In addition, the amendment to claim 7 has support on page 8, line 9 of the specification. Also, the amendment to claim 8 has support in the present specification at page 9, lines 3-7. Finally, support for the amendment to claim 9 can be found in the specification at page 13, lines 17+. Thus, no new matter has been added.

Based upon the above considerations, entry of the present amendments is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(b)

Claims 6-8 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fujii *et al.* (U.S. Patent No. 4,331,810; hereinafter "Fujii '810") (see paragraph 2 of the outstanding Office Action). This rejection is respectfully traversed, and reconsideration and withdrawal thereof are respectfully requested.

Applicants initially note that the rejection of claim 19 is rendered moot upon its cancellation.

Regarding the other disputed claims, and in the outstanding Office Action, the Examiner refers Applicants to "Example A10" (at columns 16-17) and column 13, lines 26-31 of Fujii '810. Applicants further note that in the cited Fujii '810 reference, the olefin polymerization catalyst comprises "at least a titanium component and an organoaluminum compound and belongs to the so-called composite catalysts of Ziegler type" (see column 4, lines 7-10). Namely, the catalyst is a type of multi-site catalyst having active sites of various kinds.

Therefore, one of ordinary skill in the art would understand that the polymer obtained in Example A10 in Fujii '810 is a mixture (block copolymer) of three kinds of polymers, such as propylene homopolymers, a 3-methyl-1-butene homopolymers, etc., because the polymer obtained has fusion peaks. Such fusion peaks means three melting points of 158.2°C, 277.4°C and 285.2°C, as shown in Table A1 at column 19 as disclosed in Fujii '810.

On the other hand, the copolymer used in the instantly claimed adhesive (see pending claim 6) usually has one melting point as shown in Examples 1 and 4 of Applicants' specification (see, e.g., page 17, line 22 for Example 1).

In addition, the instantly claimed copolymer has a structure in which one vinylcyclohexane unit is inserted between two propylene units, a structure in which two vinylcyclohexane units are connected and a structure in which two propylene units are connected. Thus, the instantly claimed copolymers (of propylene and vinylcyclohexane) having the recited structures cannot be obtained using the Ziegler catalyst. One can obtain the claimed copolymers by using a catalyst derived from contacting isopropylidenebis(indenyl) zirconium dichloride (see, for instance, Example 1, page 17, lines 8-15 of the present specification). Of course, Fujii '810 is silent with respect to the instantly recited structures of the random copolymer. Thus, this rejection under § 102(b) has been overcome because "a claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference". See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). That is not the case here, and withdrawal of this anticipatory rejection is respectfully requested.

Further, Applicants note that the state of the art is such that one of ordinary skill in the art would realize that it is impossible to obtain a random copolymer of a straight chain α -olefin with a bulky monomer such as vinylcyclohexane with a Ziegler type catalyst. This is an additional reason as to why this rejection has been overcome.

Therefore, as mentioned above, the instantly claimed adhesive is patentably distinct from the block copolymer disclosed in the cited Fujii '810 reference. Therefore, the instant claims cannot be rejected under 35 U.S.C. § 102(b), and reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujii '810 (see paragraph 3 of the Office Action). This rejection is respectfully traversed, and reconsideration and withdrawal thereof are respectfully requested.

As mentioned above, the copolymer used in the claimed adhesive is different from those in Fujii '810. For instance, instantly claimed copolymers of propylene and vinylcyclohexane having the recited structures cannot be obtained using the Ziegler catalyst as disclosed in Fujii '810. Thus, this rejection under § 103(a) has been overcome because a *prima facie* case of obviousness requires disclosure of all claimed features. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Reconsideration and withdrawal of this obviousness rejection are thus respectfully requested.

In addition, Applicants note that the requisite motivation, *In re Vaeck*, is lacking in that none of the *Rouffet* criteria has been met. *In re Rouffet* stands for how there are three possible sources of motivation to combine references: the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). In the instant situation regarding teaching of the cited Fujii '810 reference, this patent does not provide the required motivation for using the copolymer specified in the claimed adhesive since there is no description of the adhesion properties of its own block copolymer. Regarding knowledge of the skilled artisan and nature of problem to be solved, and as mentioned above, one of ordinary skill in the art would understand that it is impossible to obtain a random copolymer of a straight chain α -olefin with a bulky

monomer such as vinylcyclohexane with a Ziegler type catalyst. Further, the instantly claimed copolymers (of propylene and vinylcyclohexane) having the recited structures cannot be obtained using the Ziegler catalyst of Fujii '810. Thus, the *Rouffet* criteria are not met to satisfy the requisite level of motivation.

Accordingly, Applicants respectfully submit that the rejection of claim 9 has been overcome in that not all requirements for a *prima facie* case of obviousness have been satisfied. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact Eugene T. Perez (Reg. No. 48,501) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Application No. 10/024,244

Docket No.: 2185-0602P

Art Unit 1713

Reply to Office Action of October 3, 2005

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: April 3, 2006

Respectfully submitted,

By 

Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant